

## **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1, 10-12 and 15 have been amended. No new matter has been added. Thus, claims 1-18 are pending in this application and subject to examination.

In the Office Action mailed March 7, 2006, claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,873,666 to Lefebvre *et al.* ("Lefebvre") in view of Applicant's Admitted Prior Art ("AAPA"). It is noted that claims 1, 10, 11, 12 and 15 have been amended. To the extent the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejections, as follows.

### **Formal Matters**

Regarding the rejection of claims 1-18 under 35 U.S.C. § 112, second paragraph, it is respectfully submitted that claims 1, 10-12 and 15 (and, through dependency, claims 2-9, 13, 14 and 16-18) have been amended responsive to this rejection. The Applicant respectfully requests withdrawal of the rejection.

### **Claims 1, 10-12 and 15 Recite Patentable Subject Matter**

Regarding claims 1, 10-12 and 15, as amended, the Applicant respectfully submits that the cited prior art, taken alone or in combination, fails to disclose or suggest at least the feature of the present invention of "a switching circuit which

**selectively outputs counter-control signals for individually controlling operations of said plurality of counters,”** as recited in amended claims 1 and 10-12, and in the similar language in amended claim 15. (Emphasis added).

Lefebvre is directed to a first-in-first-out (“FIFO”) control circuit for providing address information to a FIFO memory, which uses two up counters—one for providing the write address, and one for providing the read address. A multiplexer selects which addresses (read or write) are used. Two storage registers are used to temporarily “hold” the output from the counters. This enables the counters to be re-loaded with their original “count” to enable either a re-reading or a re-writing of a message stored in the FIFO memory. Comparators and logic circuitry are used to provide two status output signals, namely full (or not) and empty (or not).

Counters 217 and 218, shown in FIGs. 3 and 4 of Lefebvre, perform counting based on the same Clock A, and the switching circuit (multiplexer 219) outputs write/read addresses for writing/reading in/from the RAM 212. By contrast, the claimed invention discloses a switching circuit, which outputs counter-control signals for individually controlling operations of the plurality of counters. Nothing in the AAPA cures this deficiency in Lefebvre.

Furthermore, it is respectfully submitted that the PTO has the burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient

to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

The Office Action restates the advantages of the present invention to justify the combination of references. See Office Action, at page 4. There is, however, nothing in the cited art to evidence the desirability of these advantages in the disclosed structure. Thus, the Applicants submit that a *prima facie* case of obviousness has not been established.

For at least these reasons, the Applicants respectfully submit that claims 1, 10-12 and 15, as amended, are allowable over the cited art.

#### **Claims 2-9, 13, 14 and 16-18 Recite Patentable Subject Matter**

Regarding claims 2-9, 13, 14 and 16-18, the Applicant respectfully submits that each of these claims depends from one of allowable claims 1, 12 and 15, and is therefore allowable for at least the same reasons.

#### **Conclusion**

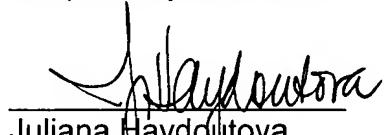
For all of the above reasons, it is respectfully submitted that the claims now pending recite patentable subject matter. Accordingly, reconsideration and

withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 107337-00056.

Respectfully submitted,



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Enclosure: Petition for Extension of Time (one month)